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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,529	07/22/1999	FUJIO NOGUCHI	450100-02002	1683

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EXAMINER

WU, DOROTHY

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 04/24/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/358,529

Applicant(s)

NOGUCHI ET AL.

Examiner

Dorothy Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said first recording medium" in page 29, lines 16-17.

There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wakui, U.S. Patent 5,648,816.

Regarding claim 1, Wakui teaches an image capturing apparatus (still video camera 1) using a plurality of recording media (col. 1, lines 7-10), wherein said image capturing apparatus comprises a detection means (memory card detecting circuit 16) for detecting the loading of a first recording medium, namely, an IC card memory 31 (col. 5, lines 64-67). Wakui also teaches

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that when the IC card memory **31** is inserted into the image capturing apparatus, a mode setting command signal is sent to the control means (system controller **2**) that sets the operation mode, which reads on the switching of the operation mode of said image capturing apparatus in accordance with a detection result obtained by said detection means (col. 8, lines 12-24).

Regarding claim 2, Wakui teaches an image capturing apparatus (still video camera **1**) comprising first operation means (IC memory card control circuit **15**) for recording an image-capturing signal on a first recording medium (IC memory card **31**) (col. 5, lines 43-46, 53-56), second operation means (flash memory control circuit **19**) for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 6, lines 32-38), and detection means (memory card detecting circuit **16**) for detecting the loading of said first recording medium (IC memory card **31**) (col. 5, lines 64-67). Wakui also teaches that the recording of image data in the second recording medium (image flash memory **20**) is stopped in response to the loading of the first recording medium (IC memory card **31**), which reads on the invalidation of the operation of said second operation means when detecting the loading of said first recording medium by using said detection means (col. 19, lines 17-22, 48-53). The control means for invalidating the second operation means is inherently taught.

Regarding claim 3, Wakui teaches an image capturing apparatus (still video camera **1**) comprising control means (system controller **2**) for switching the mode of said image capturing apparatus between a first operation mode for recording an image-capturing signal on a first recording medium (IC memory card **31**) and a second operation mode for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 8, lines 21-30); and detection means (memory card detecting circuit **16**) for detecting the loading of said first

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recording medium (col. 5, lines 64-67). Wakui teaches that said control means (system controller 2) uses said detection means (memory card detecting circuit 16) to detect the loading of said first recording medium (IC memory card 31) (Fig. 1). Wakui further teaches that the recording of image data in the second recording medium (image flash memory 20) is stopped, the operation mode is changed to the memory card record mode, and the recording of image data in the first recording medium (IC memory card 31) is started, all in response to the loading of the first recording medium (IC memory card 31), which reads on the switching of the operation mode to the first operation mode (col. 19, lines 17-22, 48-57). As the control means (system controller 2) sets the mode of the image sensing apparatus (col. 8, lines 21-30), it performs the switching of the operation mode in response to the loading of the first recording medium.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakui, U.S. Patent 5,648,816 in view of Honda, U.S. Pub. No. 2001/0014202.

Regarding claim 4, Wakui teaches an image capturing apparatus (still video camera 1) comprising control means (system controller 2) for switching the mode of said image capturing apparatus between a first operation mode and a second operation mode (col. 8, lines 21-30); and detection means (memory card detecting circuit 16) for detecting the loading of said first

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recording medium (col. 5, lines 64-67). Wakui teaches that said control means (system controller 2) uses said detection means (memory card detecting circuit 16) to detect the loading of said first recording medium (IC memory card 31) (Fig. 1). Wakui further teaches that the recording of image data in the second recording medium (image flash memory 20) is stopped, the operation mode is changed to the memory card record mode, and the recording of image data in the first recording medium (IC memory card 31) is started, all in response to the loading of the first recording medium (IC memory card 31), which reads on the switching of the operation mode to the first operation mode (col. 19, lines 17-22, 48-57). As the control means (system controller 2) sets the mode of the image sensing apparatus (col. 8, lines 21-30), it performs the switching of the operation mode in response to the loading of the first recording medium. Wakui does not teach that in the first operation mode, the image sensing apparatus records an image-capturing signal as a still picture and in the second operation mode, the image sensing apparatus records the signal as a moving picture. Honda does teach that in a first operation mode  $P_H$ , the image sensing apparatus records an image-capturing signal as a still picture and in a second operation mode  $M_V$ , the image sensing apparatus records the signal as a moving picture [0079]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a first recording medium is inserted taught by Wakui with the practice of recording still images in one mode and moving images in another taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images when an image recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to assign one recording mode as the default mode but give the other mode priority when a recording medium is inserted.

Regarding claim 5, Wakui teaches an image capturing apparatus (still video camera 1) comprising control means (system controller 2) for switching the mode of said image capturing apparatus between a first operation mode for recording an image-capturing signal as a still picture on a card recording medium (IC memory card 31) and a second operation mode (col. 8, lines 21-30); and detection means (memory card detecting circuit 16) for detecting the loading of the card recording medium (IC memory card 31) (col. 5, lines 64-67). Wakui teaches that said control means (system controller 2) uses said detection means (memory card detecting circuit 16) to detect the loading of said card recording medium (IC memory card 31) (Fig. 1). Wakui further teaches that the recording of image data in the second recording medium is stopped, the operation mode is changed to the memory card record mode, and the recording of image data in the card recording medium (IC memory card 31) is started, all in response to the loading of the card recording medium (IC memory card 31), which reads on the switching of the operation mode to the first operation mode (col. 19, lines 17-22, 48-57). As the control means (system controller 2) sets the mode of the image sensing apparatus (col. 8, lines 21-30), it performs the switching of the operation mode in response to the loading of the first recording medium. Wakui does not teach that in the second mode, the image sensing apparatus records the image-capturing signal as a moving picture on a tape recording medium. Honda does teach that in a second mode  $M_v$ , the image sensing apparatus records the image-capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording still images on a card recording medium in a first mode and moving images

on a tape recording medium in a second mode taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the video recording mode the default mode but give still image pickup priority when a card recording medium is inserted.

Regarding claim 6, Wakui teaches an image capturing apparatus (still video camera 1) comprising first operation means (IC memory card control circuit 15) for recording an image-capturing signal on a card recording medium (IC memory card 31) (col. 5, lines 43-46, 53-56), second operation means (flash memory control circuit 19) for recording an image signal (col. 6, lines 32-38), and detection means (memory card detecting circuit 16) for determining whether a card recording medium is loaded into said image capturing apparatus (col. 5, lines 64-67). Wakui teaches that said control means (system controller 2) uses said detection means (memory card detecting circuit 16) to detect the loading of said card recording medium (IC memory card 31) (Fig. 1). Wakui further teaches that the recording of image data in the second recording medium (image flash memory 20) is stopped in response to the loading of the card recording medium (IC memory card 31), which results in the invalidation of the operation of the second operation means in response to the detection of the loading of said card recording medium (col. 19, lines 17-22, 48-57). As the control means (system controller 2) sets the mode of the image sensing apparatus (col. 8, lines 21-30), it performs the switching of the operation mode in response to the loading of the card recording medium. Wakui does not teach that the second operation means records on a tape recording medium. Honda teaches an apparatus in which there is a second mode  $M_v$  in which the image sensing apparatus records the image-



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capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording images on either a card recording medium or a tape recording medium taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to record images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the mode in which images are captured on a tape recording medium the default mode but give priority to capturing images on a card recording medium when a card recording medium is inserted.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nelson et al, U.S. Patent 6,128,447, teach that a system is powered up when an electronic film unit is inserted.

Lappenbusch et al, U.S. Patent 6,297,748, teach a navigation system that periodically inputs still images or video clips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dorothy Wu whose telephone number is 703-305-8412. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 703-305-4863.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

Or faxed to:

703-872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

*Dorothy Wu*  
DW  
April 18, 2003

*KA Williams*  
Kimberly A. Williams  
Primary Examiner  
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